

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Fitz et al.

Application No.: 10/752,438

Group No.: 3738

Filed: January 5, 2004

Examiner: Stewart, Jason-Dennis Neilken

For: Patient Selectable Knee Arthroplasty Devices

Mail Stop Amendment

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

TRANSMITTAL OF SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT  
BEFORE MAILING DATE OF EITHER A FINAL ACTION  
OR NOTICE OF ALLOWANCE (37 C.F.R. § 1.97(c))

TIME OF TRANSMITTAL OF ACCOMPANYING  
SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

1. The information disclosure statement transmitted herewith is being filed *after* three months of the filing date of this national application or the date of entry of the national stage as set forth in Section 1.491 in an international application or after the mailing date of the first Office action on the merits, whichever event occurred last but *before* the mailing date of either
  - (1) a final action under § 1.113 or
  - (2) a notice of allowance under § 1.311

FEE

2. Accompanying this transmittal is the fee for submission of an information disclosure statement under section 1.97(c). (\$180.00)

FEE PAYMENT

3. Applicant elects the option to pay the fee set forth in 37 C.F.R. § 1.17(p) for submission of an information disclosure statement under § 1.97(c) (\$180.00).

Fee due \$180.00

**METHOD OF PAYMENT OF FEE**

4. Authorization is hereby made to charge the amount of \$180.00 to Deposit Account No. 19-4972.

Charge any additional fees required by this paper or credit any overpayment to Deposit Account No. 19-4972.

DATE: April 9, 2010

/Alexander J. Smolenski, Jr., Esq., #47,953/

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02960/00118 1240495.1

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: Fitz et al.

Application No.: 10/752,438

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**P.O. Box 1450**

**Alexandria, VA 22313-1450**

**SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT**

*NOTE: "An information disclosure statement shall be considered by the Office if filed by the applicant:*

- (1) Within three months of the filing date of a national application;*
- (2) Within three months of the date of entry of the national stage as set forth in section 1.491 in an international application; or*
- (3) Before the mailing date of a first Office action on the merits, whichever event occurs last." 37 C.F.R. section 1.97(b).*

*NOTE: "Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section." 37 C.F.R. section 1.56(a).*

*"Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:*

- (1) each inventor named in the application;*
- (2) each attorney or agent who prepares or prosecutes the application; and*
- (3) every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application." 37 C.F.R. section 1.56(c).*

*NOTE: The "duty as described in section 1.56 will be met so long as the information in question was cited by the Office or submitted to the Office in the manner prescribed by sections 1.97(b) - (d) and 1.98 before issuance of the patent." Notice of January 9, 1992, 1135 O.G. 13-25 at 17.*

**WARNING:** *"No information disclosure statement may be filed in a provisional application." 37 C.F.R. section 1.51(b).*

### **List of Sections Forming Part of This Supplemental Information Disclosure Statement**

The following sections are being submitted for this Supplemental Information Disclosure Statement:

*(check sections forming a part of this statement: discard unused sections and number pages consecutively)*

1. ☒ Preliminary Statements
2. ☒ Forms PTO/SB/08A and 08B (substitute for Form PTO-1449)
3. ☐ Statement as to Information Not Found in Patents or Publications
4. ☒ Identification of Prior Application in Which Listed Information Was Already Cited and for Which No Copies Are Submitted or Need Be Submitted
5. ☐ Cumulative Patents or Publications
6. ☒ Copies of Listed Information Items Accompanying This Statement
7. ☐ Concise Explanation of Non-English Language Listed Information Items
  - 7A. ☐ EPO Search Report
  - 7B. ☐ English Language Version of EPO Search Report
8. ☒ Translation(s) of Non-English Language Documents
9. ☐ Concise Explanation of English Language Listed Information Items (Optional)
10. ☒ Identification of Person(s) Making This Information Disclosure Statement

*(complete the following, if appropriate)*

Sections \_\_\_\_\_, respectively, have been continued on ADDED PAGE(S).

*NOTE : "Once the minimum requirements are met, the examiner has an obligation to consider the information." Notice of April 20, 1992 (1138 O.G. 37-41, 37).*

## **Section 1. Preliminary statements**

Applicants submit herewith patents, publications or other information, of which they are aware that they believe may be material to the examination of this application, and in respect of which, there may be a duty to disclose.

The filing of this information disclosure statement shall not be construed as a representation that a search has been made (37 C.F.R. section 1.97(g)), an admission that the information cited is, or is considered to be, material to patentability, or that no other material information exists.

The filing of this information disclosure statement shall not be construed as an admission against interest in any manner. Notice of January 9, 1992, 1135 O.G. 13-25, at 25.

**SECTION 2. FORMS PTO/SB/08A and 08B (formerly Form PTO-1449)****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants: Fitz et al. Attorney Docket: 2960/118  
Serial No: 10,752,438 Art Group Unit: 3738  
Date Filed: January 5, 2004 Examiner Name: Stewart, Jason-Dennis  
Neilken  
Invention: Patient Selectable Knee Arthroplasty

**LIST OF PATENTS AND PUBLICATIONS FOR  
APPLICANT'S SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT**

U.S. PATENT DOCUMENTS					
Examiner Initials	Reference Number	Document Number	Issue Date	Inventor	Class/Subclass
	WB	US 4,872,452	Oct. 10, 1989	Alexson	128/92
	WC	US 5,245,282	Sep. 14, 1993	Mugler, III et al.	324/309
	WD	US 5,510,121	Apr. 23, 1996	Rhee et al.	424/520
	WE	US 5,571,191	Nov. 5, 1996	Fitz	623/17
	WF	US 5,616,146	Apr. 1, 1997	Murray	606/80
	WG	US 5,759,205	Jun. 2, 1998	Valentini	623/16
	WH	US 6,013,103	Jan. 11, 2000	Kaufman et al.	623/20
	WI	US 6,151,521	Nov. 21, 2000	Guo et al.	600/407
	WJ	US 6,261,296	Jul. 17, 2001	Aebi et al.	606/90
	WK	US 6,387,131	May 14, 2002	Miehlke et al.	623/20.15
	WL	US 6,443,991	Sep. 3, 2002	Running	623/20.27
	WM	US 6,514,514	Feb. 4, 2003	Atkinson et al.	424/423
	WN	US 6,556,855	Apr. 29, 2003	Thesen	600/419
	WO	US 6,690,816	Feb. 10, 2004	Aylward et al.	382/128
	WP	US 6,702,821	Mar. 9, 2004	Bonutti	606/88
	WQ	US 6,772,026	Aug. 3, 2004	Bradbury et al.	700/98
	WR	US 6,984,981	Jan. 10, 2006	Tamez-Peña et al.	324/309
	WS	US 6,998,841	Feb. 14, 2006	Tamez-Peña et al.	324/302
	WT	US 7,050,534	May 23, 2006	Lang	378/54
	WU	US 7,058,159	June 6, 2006	Lang et al.	378/54
	WV	US 7,174,282	Feb. 6, 2007	Hollister et al.	703/2
	WW	US 7,245,697	Jul. 17, 2007	Lang	378/54
	WX	US 7,379,529	May 28, 2008	Lang	378/54
	WY	US 7,467,892	Dec. 23, 2008	Lang et al.	378/207
	WZ	US 7,468,075	Dec. 23, 2008	Lang et al.	623/16.11
	XA	US 7,534,263	May 19, 2009	Burdulis, Jr. et al.	623/14.12
	XB	US 7,634,119	Dec. 15, 2009	Tsougarakis, et al.	382/128

Applicants:	Fitz et al.	Attorney Docket:	2960/118
Serial No:	10/752,438	Art Group Unit:	3738
Date Filed:	January 5, 2004	Examiner Name:	Stewart, Jason-Dennis Neilken
Invention:	Patient Selectable Knee Arthroplasty Devices		

**LIST OF PATENTS AND PUBLICATIONS FOR  
APPLICANT'S SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT**

U.S. PATENT PUBLICATION DOCUMENTS					
Examiner Initials	Reference Number	Document Number	Publication Date	Inventor	Class/Subclass
	XC	US 2002/0067798	Jun. 6, 2002	Lang et al.	378/54
	XD	US 2003/0031292	Feb. 13, 2003	Lang	378/54
	XE	US 2003/0045935	Mar. 6, 2003	Angelucci et al.	623/17.11
	XF	US 2003/0063704	Apr. 3, 2003	Lang	378/54
	XG	US 2004/0062358	Apr. 1, 2004	Lang et al.	378/207
	XH	US 2004/0081287	Apr. 29, 2004	Lang et al.	378/210
	XI	US 2005/0010106	Jan. 13, 2005	Lang et al.	600/425
	XJ	US 2005/0078802	Apr. 14, 2005	Lang et al.	387/207
	XK	US 2005/0226374	Oct. 13, 2005	Lang et al.	378/54
	XL	US 2006/0210017	Sep. 21, 2006	Lang	378/54
	XM	US 2006/0210018	Sep. 21, 2006	Lang	378/54
	XN	US 2007/0047794	Mar. 1, 2007	Lang et al.	378/132
	XO	US 2007/0083266	Apr. 12, 2007	Lang	623/17.11
	XP	US 2007/0156171	Jul. 5, 2007	Lang et al.	606/205
	XQ	US 2007/0233269	Oct. 4, 2007	Steines et al.	623/20.21
	XR	US 2007/0250169	Oct. 25, 2007	Lang	623/17.12
	XS	US 2007/0274444	Nov. 29, 2007	Lang	378/54
	XT	US 2008/0025463	Jan. 31, 2008	Lang	378/54
	XU	US 2008/0031412	Feb. 7, 2008	Lang et al.	378/54
	XV	US 2008/0058613	Mar. 6, 2008	Lang et al.	600/300
	XW	US 2008/0170659	Jul. 17, 2008	Lang et al.	378/56
	XX	US 2008/0195216	Aug. 14, 2008	Lang	623/18.11
	XY	US 2008/0219412	Sep. 11, 2008	Lang	378/207
	XZ	US 2008/0243127	Oct. 2, 2008	Lang et al.	606/87
	YA	US 2008/0275452	Nov. 6, 2008	Lang et al.	606/88
	YB	US 2008/0281328	Nov. 13, 2008	Lang et al.	606/87
	YC	US 2008/0281329	Nov. 13, 2008	Fitz et al.	623/17.16
	YD	US 2008/0281426	Nov. 13, 2008	Fitz et al.	623/17.16
	YE	US 2009/0076371	Mar. 19, 2009	Lang et al.	600/407

Applicants:	Fitz et al.	Attorney Docket:	2960/118
Serial No:	10/752,438	Art Group Unit:	3738
Date Filed:	January 5, 2004	Examiner Name:	Stewart, Jason-Dennis Neilken
Invention:	Patient Selectable Knee Arthroplasty Devices		

**LIST OF PATENTS AND PUBLICATIONS FOR  
APPLICANT'S SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT**

<b>FOREIGN PATENT DOCUMENTS</b>						
<b>Examiner Initials</b>	<b>Reference Number</b>	<b>Country Code</b>	<b>Document Number</b>	<b>Publication Date</b>	<b>Patentee or Applicant</b>	<b>Class/Subclass</b>
	<b>YF</b>	<b>DE</b>	<b>101 35 771</b>	<b>Feb. 20, 2003</b>	<b>Aesculap AG &amp; Co. KG</b>	<b>A61B 17/70</b>
	<b>YG</b>	<b>DE</b>	<b>101 35 771</b> (English Abstract)	<b>Feb. 20, 2003</b>	<b>Aesculap AG &amp; Co. KG</b>	<b>A61B 17/70</b>
	<b>YH</b>	<b>EP</b>	<b>1 437 101</b>	<b>Jul. 14, 2004</b>	<b>DePuy AcroMed, Inc.</b>	<b>A61F 2/08</b>
	<b>YI</b>	<b>WO</b>	<b>2004/051301</b>	<b>Jun. 17, 2004</b>	<b>Imaging Therapeutics, Inc.</b>	<b>G01R 33/56</b>
	<b>YJ</b>	<b>WO</b>	<b>2005/020850</b>	<b>Mar. 10, 2005</b>	<b>Gerraspine A.G.</b>	<b>A61F</b>
	<b>YK</b>	<b>WO</b>	<b>2006/060795</b>	<b>Jun. 8, 2006</b>	<b>ConforMIS, Inc.</b>	<b>A61B 17/17</b>
	<b>YL</b>	<b>WO</b>	<b>2006/065774</b>	<b>Jun. 22, 2006</b>	<b>St. Francis Medical Technologies, Inc.</b>	<b>A61F 2/44</b>
	<b>YM</b>	<b>WO</b>	<b>2007/062079</b>	<b>May 31, 2007</b>	<b>Lang</b>	<b>A61F 2/30</b>
	<b>YN</b>	<b>WO</b>	<b>2007/092841</b>	<b>Aug. 16, 2007</b>	<b>ConforMIS, Inc.</b>	<b>A61B 17/15</b>
	<b>YO</b>	<b>WO</b>	<b>2008/157412</b>	<b>Dec. 24, 2008</b>	<b>ConforMIS, Inc.</b>	<b>A61B 17/17</b>
	<b>YP</b>	<b>WO</b>	<b>2009/140294</b>	<b>Nov. 19, 2009</b>	<b>ConforMIS, Inc.</b>	<b>A61F 2/30</b>

<b>OTHER DOCUMENTS</b>			
<b>Examiner Initials</b>	<b>Reference Number</b>	<b>Author</b>	<b>Title of Article, Title of Journal, Volume Number, Page Numbers, Date</b>
	<b>YQ</b>	United States Patent and Trademark Office	Office Action dated April 24, 2009, pertaining to Application No. 10/704,208, 23 pages
	<b>YR</b>	Sunstein Kann Murphy & Timbers LLP	Request for Continued Examination and Response dated October 26, 2009, pertaining to Application No. 10/704,208, 17 pages
	<b>YS</b>	United States Patent and Trademark Office	Office Action dated December 30, 2009, pertaining to Application No. 10/704,208, 10 pages
	<b>YT</b>	European Patent Office	European Search Report, Application No. 06838227.4, together with the European Search Opinion, dated March 3, 2010, 6 pages



Applicants:	Fitz et al.	Attorney Docket:	2960/118
Serial No:	10/752,438	Art Group Unit:	3738
Date Filed:	January 5, 2004	Examiner Name:	Stewart, Jason-Dennis Neilken
Invention:	Patient Selectable Knee Arthroplasty Devices		

**LIST OF PATENTS AND PUBLICATIONS FOR  
APPLICANT'S SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT**

Examiner Signature: \_\_\_\_\_

Date Considered: \_\_\_\_\_

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; draw line through citation *if not* in conformance and not considered. Include copy of this form with next communication to applicant.

#### **Section 4. Identification of Prior Application in Which Listed Information Was Already Cited and for Which No Copies Are Submitted or Need Be Submitted**

*NOTE: "A copy of any patent, publication or other information listed in an information disclosure statement is not required to be provided if it was previously cited by or submitted to the Office in a prior application, provided that the prior application is properly identified in the statement and relied upon for an earlier filing date under 35 U.S.C. 120." 37 C.F.R. section 1.98(d).*

**WARNING:** *"This exception to the requirement for copies of information does not apply to information which was cited in an international application under the Patent Cooperation Treaty." Notice of April 20, 1992 (1138 O.G. 37-41, 38).*

**WARNING:** *"Information which is cited or submitted to the Office in the parent application of a file wrapper continuing application under 37 C.F.R. section 1.62 will be part of the file before the examiner and need not be resubmitted in the continuing application. Likewise, the examiner will consider information cited or submitted to the Office in a parent application when examining a continuing application and thus this information need not be resubmitted unless applicant desires the information to be printed on the patent." Notice of April 20, 1992 (1138 O.G. 37-41, 37).*

**WARNING:** *While a copy of a non-English language item of information need not be submitted, if it was previously submitted to, or cited by, the Office in a prior application, provided it is properly identified in this statement and this application relies on that earlier filing date under 35 U.S.C. 120, nevertheless, the requirement in section 1.98(a)(3) for a concise explanation of non-English language information would not be satisfied by a statement that a reference was cited in the prosecution of a parent application. The concise explanation must explain the relevance, as presently understood by the person designated in section 1.56(c) most knowledgeable about the content of the information. Notice of January 9, 1992, 1135 O.G. 13-25, at 20.*

This application relies, under 35 U.S.C. section 120, on the earlier filing date of prior application SN.: 10/160,667, filed on May 28, 2002.

The following references were submitted to, and/or cited by, the Office in the prior application(s) and, therefore, are not required to be provided in this application:

**WB – YT**

## Section 6. Copies of Listed Information Items Accompanying This Statement

*NOTE: 37 C.F.R. section 1.98(a)(2) requires that any information disclosure statement filed under section 1.97 shall include: "A legible copy of: (I) Each U.S. and foreign patent; (ii) Each publication or that portion which caused it to be listed; and (iii) All other information or that portion which caused it to be listed, except that no copy of a U.S. patent application need be included . . ."*

*NOTE: The wording in section 1.98(a)(2)(iii) makes it clear that the requirement to submit a copy of each item of information listed in an information disclosure statement does not apply to the citation of a U.S. patent application. Notice of January 9, 1992, 1135 O.G. 13-25, at 14.*

Legible copies of all items listed in Forms PTO/SB/08A and 08B (substitute for Form PTO-1449) accompany this information statement.

*(complete the following, if applicable)*

☒ Exception(s) to above:

**U.S. patent citations are not included pursuant to the United State Patent and Trademarks Office's September 21, 2004 waiver of the copy requirement in 37 CFR 1.98 for cited pending U.S. patent citations when the patent citations are available in the USPTO's IFW system.**

☐ Items in prior application, from which an earlier filing date is claimed for this application, as identified in Section 4.

☐ Cumulative patents or publications identified in Section 5.

## Section 8. Translation(s) of Non-English Language Documents

*NOTE: "If a written English language translation of a non-English language document, or portion thereof, is within the possession, custody or control of, or is readily available to any individual designated in section 1.56(c), a copy of the translation shall accompany the statement." 37 C.F.R. section 1.98(c).*

*NOTE: "The Office does not intend to require translations unless they have been reduced to writing and are actually translations of what is contained in the non-English language information. Applicants should note, however, that most examiners do not have the ability to understand information which is not in English and that the Office will not routinely translate information submitted in a non-English language. The examiner will consider the information insofar as it is understood on its face, e.g., drawings, chemical formulas, English language abstracts, but will not have the information translated unless it appears to be necessary to do so. Applicants are required to aid the examiner by complying with the requirements for a concise explanation in section 1.98(a)(3) for information submitted in a non-English language." Notice of January 9, 1992, 1135 O.G. 13-25, at 21.*

*NOTE: "The examiner will indicate that the non-English language information has been considered in the same manner as consideration is indicated for information submitted in English." Notice of April 20, 1992 (1138 O.G. 37-41, 41).*

[ ] Submitted herewith is an English translation of the following foreign language patents, publications or information or of those portions of those patents, publications or information considered to be material:

**Reference YG is believed to be an abstract in the English language of Reference YF.**

[X] No English language translations of the foreign language patents, publications or information or parts thereof are readily available, except for those listed above.

[ ] The following foreign language documents submitted are believed to be the equivalent or substantial equivalent of the English language documents identified below, which are also submitted herewith.

## Section 10. Identification of Person(s) Making This Information Disclosure Statement

The person making this certification is

*(check each applicable item)*

- (a) ☐ the inventor(s) who signs below

\_\_\_\_\_  
**SIGNATURE OF INVENTOR**

\_\_\_\_\_  
*(type name of inventor who is signing)*

- (b) ☐ an individual associated with the filing and prosecution of this application (37 C.F.R. section 1.56(c))

\_\_\_\_\_  
**SIGNATURE OF INVENTOR**

\_\_\_\_\_  
*(type name of inventor who is signing)*

- (c) ☒ the practitioner who signs below on the basis of the information:

*(check each applicable item)*

☐ supplied by the inventor(s).

☐ supplied by an individual associated with the filing and prosecution of this application. (37 C.F.R. section 1.56(c)).

☒ in the practitioner's file.

Reg. No.: 47,953

Tel. No.: (617) 443-9292

Customer No.: 002101

02960/00118 1240494.1

/Alexander J. Smolenski, Jr., Esq. #47,953/

**SIGNATURE OF PRACTITIONER**

Alexander J. Smolenski, Jr., Esq.

*(type or print name of practitioner)*

125 Summer Street, 11<sup>th</sup> Floor

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Boston, MA 02110-1618